

REMARKS/ARGUMENTS

I. Status of the Claims

Prior to entry of this amendment, claims 1-33 were pending in the application. A final office action mailed February 24, 2005 rejected claims 1-4, 69-, 11-15, 17, 19, 23 and 26 under 35 U.S.C. § 103(a) as unpatentable over the combination of USP 6,009,459 ("Belfiore"), USP 5,881,131 ("Farris") and USP 6,041,326 ("Amro"). The office action also rejected claims 5, 10, 16, 18, 20, 21, 22, 24, 25 and 27 under § 103(a) as unpatentable over the Belfiore, Farris and Amro, together with USP 6,442,523 ("Siegel"). Claims 28-33 were rejected under § 103(a) as unpatentable over the combination of Belfiore, Farris, Amro and Siegel, in view of USP 5,898,836 ("Freivald").

This amendment serves as the requisite submission for the Request for Continued Examination filed herewith, and it amends claims 1, 3, 5, 6, 8-10, 12, 14-16, 28, 30 and 32. No claims have been canceled, but new claim 34 has been added. Hence, after entry of this amendment, claims 1-34 stand pending for examination.

II. Claim Amendments

Claims 1, 3, 5, 6, 8-10, 12, 14-16, 28, 30 and 32 have been amended. Many of the claims have been amended to recite "at least one trademark, tradename, celebrity name, ~~or~~ and/or famous name to be searched in the Web page on the Internet," in order to prevent any inference that the scope of the amended phrase might be limited to only one of the listed items. These amendments likewise do not narrow the scope of the claims.

Claims 1 and 5 have been amended to recite "receiving, from entering, by a user, the at least one trademark" Support for this limitation may be found, inter alia, at lines 17-18 on page 12 of the application.

Claims 1 and 5 also have been amended to delete the phrase "comparing current search results with prior search results to determine" and thus to recite merely "determining an unauthorized use of the at least one trademark, tradename, celebrity name, and/or famous name,"

so as to remove an unnecessary limitation from the claims. Claims 6, 10, 12 and 16 have been amended in similar fashion. It is submitted that these amendments do not narrow the scope of the amended claims.

Claims 6 and 10 have also been amended cosmetically to add line breaks and thereby improve readability. It submitted that these amendments also do not narrow the scope of the claims.

Claims 6 and 10 have been amended further to recite certain limitations in active voice, in order to improve the readability of the claims. It is submitted that these amendments do not change the scope of the amended claims.

Claims 28, 30 and 32 have been amended to recite "a name and an address of the owner." Support for this amendment may be found, inter alia, at lines 5-6 on page 15 of the application.

New claim 34 has been added. Support for claim 34 can be found, inter alia, at line 16-23 on page 12 of the application, lines 1-23 on page 13 of the application, lines 20-23 on page 14 of the application, and line 4-6 on page 15 of the application.

III. Claim Rejections under 35 U.S.C. §103

The office action rejected claims 1-33 as unpatentable over various combinations of Belfiore, Farris, Amro, Siegel and Freivald. Even taken together, however, the cited references fail to teach or suggest each limitation of any pending claim. Moreover, the office action has identified no permissible motivation or suggestion to combine the references in the contemplated manner, so even if the cited references did collectively teach disclose the limitations of the pending claims, they could not be combined to form a prima facie case of obviousness under § 103(a). Hence, the applicants respectfully traverse the rejections.

Claim 1-33, taken broadly, are directed to systems, methods and software programs for "for searching and reporting an incidence of at least one of a trademark, a tradename, a celebrity name, and/or a famous name in a Web page on the Internet." Of the cited references, only one (Farris) even appears to mention the concept of a trademark, and Farris does

so only in the context of ensuring that a desired domain name is not duplicative of any registered trademarks. This is a far cry from the systems, methods and software programs recited by claims 1-33. The other references, respectively, disclose systems for “automatically initiating a search when a user enters text that cannot be properly interpreted as a URL” (Belfiore, c. 3, ll. 59-61), systems for “allowing a user to customize on-line search engines for on-line data searches” (Amro, c. 4, ll.8-9), “a method and apparatus that enables young, pre-reading children to use components of written, phonetic or phonetic representations of language for communication” (Siegel, c. 2, ll. 62-65) and “[a] change-detection web server [that] automatically checks web-page documents for recent changes” (Frievald, abstract).

Not surprisingly, even when combined, these five references fail to teach or suggest the limitations of even the independent claims in the application. Merely by way of example, independent claim 1 recites, inter alia, “determining an unauthorized use of the at least one trademark, tradename, celebrity name, and/or famous name.” Nothing in any of the cited references discloses this limitation. Even assuming the cited references collectively do teach or suggest searching for a particular trademark (a proposition the applicants would dispute), they fail to teach or suggest that any search results might be analyzed to determine an unauthorized use of the trademark.

Indeed, the only cited reference even to refer to a trademark does so only in the context of “Trademark Clearance” (Farris, c. 30, l. 46). That is, in describing generally “some of the more important legal issues that relate to the offering of goods/services via a web site on the Internet,” (c. 29, ll. 17-19) Farris mentions that, in selecting a domain name, “a search of trademarks and tradenames used in the United States should be performed” (c. 30, ll.48-49). Farris, however, does not teach or suggest that its disclosed system (or any system, for that matter) might be used to perform such a search, or, more importantly how such a search might be used to perform the recited claim element of determining an unauthorized use.

For at least this reason, independent claims 1, 5, 6, 10, 12 and 16 are allowable over the cited references.

Additionally, independent claim 5 recites, inter alia, “informing the owner [of the URL address] of the unauthorized use.” Claims 10 and 16 include similar limitations. The office action appears to ignore this claim element, and none of the cited references teach or suggest this element. For at least this additional reason, claims 5, 10 and 16 are allowable over the cited combination.

Dependent claims 2-4, 7-9, 11, 13-15 and 17-33 are allowable as depending from allowable base claims and as being directed to specific novel substitutes. Merely by way of example, amended claim 32 recites that “the information relating to the owner of the URL address conducting the unauthorized use includes a name and an address of the owner.” The office action asserts that “Freivald teaches . . . [that] a unique URL is specified for each web page including password or name and address information.” Freivald does not disclose, however, that this information might be the name and address of the owner of the URL. Instead, from the disclosure of Freivald, it is clear that Freivald is discussing how URLs generally are conceived, which has nothing to do with the name or address of the owner of the URL. Claim 32, and claims 28 and 30, which include similar claim elements, therefore are allowable over the cited references for this additional reason.

Similarly, claim 33 (along with claims 29 and 31) recites, inter alia, that “the owner is informed of the unauthorized use by delivery of a cease and desist letter.” Nothing in the cited references teaches or suggests this limitation, and the office action appears to ignore this limitation in rejecting these claims. For at least this additional reason, claims 29, 31 and 33 are allowable over the cited references.

As noted above, new claim 34 has been added. No combination of the cited references discloses each of the limitations of new claim 34, and claim 34 therefore is believed to be allowable over the cited references.

Furthermore, even if the cited references collectively did teach each element of any pending claim, there is no suggestion in any of the references that would motivate one

skilled in the art to combine the references in the manner contemplated by the office action. The office action (p. 5) posits that one skilled in the art might be motivated to combine the references “to provide a search over the Internet for potentially [sic] user of trademarks in domain names and other web page content in order to enforce the trademark rights within the whole Internet.” As noted above, however, while both Belfiore and Arno deal with Internet searching, neither of them even mentions the concept of trademarks, let alone enforcing trademark rights. Moreover, while Farris does mention a few general trademark issues raised by the concept of domain names, Farris does not discuss enforcing trademark rights, but rather ensuring, when provisioning a new domain name, that the selected domain name does not infringe another’s trademark. Hence, nothing in any of the references would lead one skilled in the art to believe that the systems disclosed by those references might even be used for trademark enforcement, let alone how they might be combined to do so.

Hence, the office action’s suggested motivation to combine the references comes only from the present disclosure, a classic argument from hindsight. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000), which is cited by MPEP § 2103.43, warns against this “hindsight problem” and admonishes that the examiner must provide an explicit or implicit showing of a suggestion or motivation to modify or combine references: “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. . . . Whether the [examiner] relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not ‘evidence.’” *Id.* (citations omitted).

The office action makes no such showing. It is beyond dispute that the references, even taken together, fail to show any explicit motivation or suggestion that they might be combined in the contemplated manner. Moreover, since the combined teachings fail even to mention trademark enforcement (the purported motivation), it is difficult to see how they might contain any implicit motivation or suggestion that they might be combined for this purpose. Hence, there has been no showing of any suggestion or motivation to combine the

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references in the manner contemplated by the office action, and the rejections § 103(a) therefore would be improper even if the combination of the cited references disclosed each limitation of any pending claim (which, as noted above, they do not).

For at least the above reasons, all pending claims are believed to be allowable. Hence, the applicants respectfully request the withdrawal of the rejections of claims 1-33 and a timely notice of allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is cordially invited to telephone the undersigned at 303-571-4000.

Respectfully submitted,

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